

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/436,455 11/08/99 DANEK

C 435712000921

EXAMINER

QM32/0725

MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO CA 94304-1018

SHAY, D

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

07/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO
---------------	-------------	----------------------	--------------------

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSION OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on February 16, 2021 ☐ This action is made

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO- |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-78 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-79 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit: 3739

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-43, 64, 68 and 69^{are} rejected under 35 U.S.C. 112, second paragraph, as being ~~in~~ indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18 "said distal joint" lacks positive antecedent basisⁱ. In claims 26 and 64, "said ~~the~~ temperature detecting element" lacks antecedent basis^a. Claim 38 is indefinite ~~is~~ the "other ~~the~~ means" referred to is unclear. In claims 68 and 69 "said vision system" lacks positive antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 11-13, 18, 20-22, 24, 25, 30, 38, 44, 45, 54-57, 65, 67, 73, 74, and 76 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fischell et al.

See figures 2-4; the full paragraph on page 12; and the paragraph spanning pages 13 and 14.

Claims 1-3, 6-8, 10-12, 14-16, 18, 19, 23, 35, 41, 54-57, 70, 71, 73, 74 and ~~75~~⁷⁶ are ~~the~~ rejected under 35 U.S.C. 102(b) as being clearly anticipated by Spears.

Art Unit: 3739

Claims 1, 3-6, 11, 13, 18-21, 30, 31, 37, 38, 54-61, and 70 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kodis. *2*

Claims 1, 3-6, 8, 10-13, 18-21, 30, 38-40, 44-64, and 66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Edwards et al.

Claims 74, 75, and 78 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gregory.

Claims 1-11, 14-19, 21-23, 26-33, 38-40, 44, 45, 54-65, 70, 71 and 74 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jackson et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 36, 42, 43, 53, 68, 69, 72, 73 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson et al. Jackson et al teach a device such as claimed except specifically calling for sterilization, the visualization system; electrically conductive paint; locating the temperature detector between the leg and the resistively heated element, forming the legs from a single sheet of stainless steel; and including an optical fiber and CCD. It would have *official notice of which is hereby taken; since they provide no unexpected result; and* been obvious to employ these measures, since they are notorious in the medical arts *since they are not critical, thus* producing a device such as claimed. *2*

Application/Control Number: 09/436,455

Page 4

Art Unit: 3739

Any inquiry concerning this communication should be directed to David Shay at
telephone number (703) 308-2215.

David Shay:bhw
July 13, 2001

A handwritten signature in black ink, appearing to read "David Shay", with a stylized flourish at the end.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.